

Claim 44 finds support at Claim 27 as originally filed.

No new matter is believed to have been added by entry of the amendments. Upon entry of the amendments, Claims 1-44 will be active. Entry and favorable consideration are respectfully requested.

REMARKS

Applicants elect Group I, Claims 1-27 with traverse. In addition, Applicants elect the following species, also with traverse:

- (i) isododecane as the volatile hydrocarbon-based solvent;
- (ii) phenyltrimethicone as the non-volatile silicone; and
- (iii) diglyceryl diisostearate as the non-volatile hydrocarbon-based oil.

Claims 1-44 read on the elected species.

The Office is requiring restriction and election in this application under 35 U.S.C. §121. The restriction and election requirements are respectfully traversed. Applicants respectfully submit that the Office has not provided sufficient reasons to establish that restriction should be required in this application.

The requirements for restriction are two-fold: (A) the inventions must be independent or distinct; and (B) there must be a serious burden on the Examiner if restriction were not required. MPEP §803.

The Office alleges that Groups I and II are distinct on the grounds that "the process as claimed can be made by layering the components rather than maintaining them in contact with each other." Official Action paragraph 2. The Office has not shown that the claimed product can in fact be made as the Office has suggested or that its suggested process is materially different from the claimed process. Applicants respectfully request the Office to

document a viable alternative process or product or withdraw the requirement as unsustainable.

The Office alleges that Groups I and III are distinct on the grounds that "any number of products can be applied to the lips or skin." Official Action paragraph 3. In this instance, the Office has not fulfilled its burden to show that "any number of products" are materially different from what is claimed. In particular, the sole claim in Group III (Claim 29) recites a process comprising the very product under Group I. Given this express recitation in the process claim, the Office's assertion that "any number of products" may be applied to the lips or the skin falls well short of what is required to uphold restriction. This ground of restriction is unsustainable, and it should be withdrawn.

The Office asserts that Groups I and IV are distinct because "other transfer resistant cosmetics are known." Official Action paragraph 4. Even if the Office's assertion that "other transfer resistant cosmetics are known" were true, this would have absolutely no bearing on the restriction requirement at hand. The Office has not provided any reason to conclude that the "other transfer resistant cosmetics" are materially different from what is claimed. By this omission, the Office has failed to provide even an example that would support an assertion of distinctness under MPEP §806.05(h). In addition, a review of the claimed process shows that a particular product is required. How can the process as claimed be practiced with another product? This ground of restriction is unsustainable, and it should be withdrawn.

The Office does not provide any support for restricting between Group II and either Groups III or IV. The Office likewise fails to provide any support for restricting between Groups III and IV. In so doing, the Office has failed to meet its burden under MPEP §§814, 815, and 816. The restriction requirement between these groups is unsustainable, and it should be withdrawn accordingly.

The Office has not made out a *prima facie* case of serious burden with respect to Groups I and II, because the Office has classified them in the same subclass. With respect to the remaining groups, Applicants respectfully submit that a search of only three subclasses would not pose a serious burden on the Office, noting that thousands of U.S. patents have issued in which many more than three subclasses have been searched.

For all the reasons given above, the restriction requirement is improper, and it should be withdrawn.

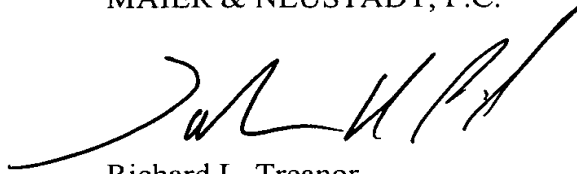
In the event that the restriction requirement is maintained, however, and should the elected invention be found allowable, Applicants respectfully request the Office to rejoin the non-elected groups with the elected group. It is notable that the Office encourages this policy under MPEP §821.04.

The election of species requirement is likewise traversed. The Office has not provided sufficient reasons to conclude that the species are indeed patentably distinct. Accordingly, Applicants' election of species is made for search purposes only. Applicants respectfully remind the Office that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application. 37 C.F.R. §1.141. Applicants respectfully submit that the claims do not present an unreasonable number of species and, should no prior art be found that anticipates or renders obvious the elected species, the search should be extended to include the non-elected species.

Applicants respectfully submit that this application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



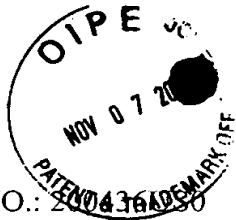
Richard L. Treanor
Attorney of Record
Registration No. 36,379

John K. Pike, Ph.D.
Registration No. 41,253



22850

(703) 413-3000
Fax No.: (703) 413-2220
NFO:RLT:JKP\la
I:\atty\JKP\200436us-am.wpd



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IN THE CLAIMS

Claims 31-44 (New).